



THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Karsten Andersen, et al.

SERIAL NO.: 10/613,396

Confirmation No.: 4469

**COPY**

FILING DATE: July 3, 2003

TITLE: SYSTEM AND PROCESS FOR TRANSPORTING WIND TURBINES

EXAMINER: Gutman, Hilary L.

ART UNIT: 3612

**CERTIFICATE OF MAILING**

I hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, on the date printed below:

Date: 3/27/06

Name: Annette Valdivia  
Annette Valdivia

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PETITION UNDER 37 CFR 1.144**

Dear Sir:

Applicants hereby petition the Commissioner pursuant to 37 CFR 1.144 and MPEP 818.03(c).

**The Restriction Requirement**

In paragraph 1 of an Office Action of September 16, 2004, the Examiner asserted her restriction requirement. The Applicants traversed the restriction requirement in their response mailed February 16, 2005. Thereafter in an Office Action of May 4, 2005, the Examiner made the restriction requirement final.

The restriction requirement states:

Species A is directed to Figures 3-17 and Claims 1-7 and 9-10;  
Species B is directed to Figures 19-25 and Claim 8;  
Species C is directed to Figures 26-32; and,  
Species D is directed to Figures 33-45.

### **The Restriction Requirement is Not Proper**

The Restriction Requirement is not proper for two reasons. First, it is not clear, and second it is improperly based on figures rather than claims.

#### **Restriction requirements must be clear**

There can be no doubt that restriction requirements must be clear. For example, MPEP §809.02(a) requires the examiner to, “Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, to which claims are restricted.” Moreover, the heading of MPEP §814 enjoins the examiner to “Indicate Exactly How Application Is To Be Restricted.”

There are many reasons for the requirement of clarity. For example, if a restriction requirement has been imposed and thereafter an applicant files a divisional application, 35 USC §121 provides, in relevant part:

A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

The Court of Appeals for the Federal Circuit has explained that 35 U.S.C. §121 will not apply to remove the parent as a reference where the principle of consonance is violated:

“Consonance requires that the line of demarcation between the “independent and distinct inventions” that prompted the restriction requirement be maintained. Though the claims may be amended, they must not be so amended as to bring them back over the line imposed in the restriction requirement. Where that line is crossed the prohibition of the third sentence of Section 121 does not apply.” Gerber Garment

Technology, Inc. v. Lectra Systems, Inc., 916 F.2d 683, 688, 16 U.S.P.Q.2d (BNA) 1436, 1440 (Fed. Cir. 1990).

In the case of Geneva Pharmaceuticals, Inc., V. Glaxosmithkline Plc et al., 349 F.3d 1373; 2003 U.S. App. LEXIS 23795; 68 U.S.P.Q.2D (BNA) 186 (Fed Cir. 2003) the Court of Appeals for the Federal Circuit emphasized the importance of clarity in restriction requirements.

Section 121 shields claims against a double patenting challenge if consonance exists between the divided groups of claims and an earlier restriction requirement. Symbol Techs., Inc. v. Opticon, Inc., 935 F.2d 1569, 1579 (Fed. Cir. 1991) ("Consonance requires that the line of demarcation between the 'independent and distinct inventions' that prompted the restriction requirement be maintained . . . . Where that line is crossed the prohibition of the third sentence of Section 121 does not apply.") (quoting Gerber Garment Tech., Inc. v. Lectra Sys., Inc., 916 F.2d 683, 688 (Fed. Cir. 1990)). If a restriction requirement does not clearly set forth the line of demarcation, then challenged claims could not satisfy the consonance requirement. Therefore restriction requirements must provide a clear demarcation between restricted subject matter to allow determination that claims in continuing applications are consonant and therefore deserving of § 121's protections. 349 F.3d 1373, 1381, emphasis added.

Turning now to the present case, the Applicants respectfully point out that the restriction requirement is unclear in a number of respects. The following are some examples.

The Examiner's alleged Species B and C both appear to concern allowed claims, e.g. Claim 11. Allowed Claim 11 concerns transportation of blades and nacelles. On the other hand, the Examiner's alleged Species B is directed to Figures 19-25 which concern transportation of blades as indicated at page 6, lines 16-21 of the specification. The Examiner's alleged Species C is directed to Figures 26-32 which concern transportation of nacelles as indicated at page 6, line 23 through page 7, line 1 of the specification. Accordingly, the Applicants do not understand how they could reasonably respond to the restriction requirement. It would seem to be

impossible for the Applicants to elect one of the Examiner's alleged species and still maintain Claim 11.

The Restriction Requirement does not mention Claim 11, which the Examiner has allowed. This leads to uncertainty concerning the status of Claim 11.

As another example of the lack of clarity of the restriction requirement, the Examiner's alleged Species C is "directed to Figures 26-32" and Species D is "directed to Figures 33-45". There are at least two problems with these alleged "Species". First, the Examiner identified no claims connected with Species C or D, and identified all claims as connected to Species A or B. This defies logic. If Applicants had elected Species C or D then would they have been unable to pursue any claims? It is plain that Figures 26-32 and 33-45 relate to claims of the application. For example, Claim 11 concerns nacelles and nacelles 10 are shown in Figure 26, and Claims 1-7 are related to tower sections and tower sections 50, 250-258 are shown in Figures 33-37 and 45.

Furthermore, to the best of the Applicants' understanding, alleged Species D appears to relate to tower sections 50, 250-258, shown in Figs. 33 and 34. However, tower sections are also shown in Figures 3, 4 and 16 which the Examiner alleges are Species A. Accordingly, the Applicants do not understand how they could reasonably respond to the restriction requirement.

The Examiner's alleged Species A and D both appear to concern allowed claims, e.g. Claim 1. Allowed Claim 1 concerns transportation of tower sections. The Examiner's alleged Species A is directed to Figures 3-17 which concern transportation of tower sections 50 and 52. On the other hand, the Examiner's alleged Species D is directed to Figures 33-45 which also concern transportation tower sections 50 and 250-258. Accordingly, the Applicants do not understand how they could reasonably respond to the restriction requirement. It would seem to be impossible for the Applicants to elect one of the Examiner's alleged species and still maintain Claim 1.

**A restriction requirement be based on claims, not on figures**

The statutory basis for restriction requirements refers to **claims**, not figures. “If two or more independent and distinct inventions are **claimed** in one application, the Director may require the application to be restricted to one of the inventions.” 35 USC §121 (emphasis added.)

Furthermore, the Manual of Patent Examining Procedure (MPEP) does not allow the restriction requirement imposed by the Examiner. The MPEP requires that an Examiner must base a restriction requirement on the **claims**, not the figures in an application.

The MPEP clearly requires an Examiner to base a restriction on the **claims**. There are many examples of this throughout Chapter 800, which governs restriction practice, and some of the most prominent are recited below.

“In passing upon questions of double patenting and restriction, it is the **claimed** subject matter that is considered and such **claimed** subject matter must be compared in order to determine the question of distinctness and independence.” MPEP § 806.01.

“Where the **claims** of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction therebetween should never be required.” MPEP § 806.03.

“Where an applicant files a divisional application claiming species **claimed** but not elected in the parent case . . . there should be no determination of whether or not the species **claimed** in the divisional is patentable over the species retained in the parent case since that determination was made before the requirement to restrict was made. . . . “[T]he Examiner should not require restriction to a reasonable number of species unless he or she is satisfied that he or

she would be prepared to allow **claims** to each of the **claimed** species over the parent case, if presented in a divisional application. . .” MPEP § 806.04(h).

The form Outline of Letter for Restriction requires the Examiner to, “List **claims** in each group.” MPEP § 817 Outline of Letter (a)(2).

### **Requested Relief**

The Applicants request that the restriction requirement be withdrawn and a new restriction requirement be substituted as follows:

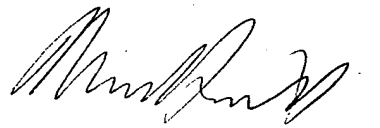
Group A directed to Claims 1-7 and 9-31.  
Group B directed to Claim 8.

Applicants would respond to this restriction requirement by electing Claims 1-7 and 9-31.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,  
THELEN REID & PRIEST, LLP



Marc Hanish  
Reg. No. 42,626

Dated: \_\_\_\_\_

3/27/06

Thelen Reid & Priest LLP  
P.O. Box 640640  
San Jose, CA 95164-0640  
Tel. (408) 292-5800  
Fax. (408) 287-8040